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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,109

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Klaus Kulper

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07/06/2009

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EXAMINER

PATEL, RONAK C

ART UNIT

PAPER NUMBER

4132

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,109	<b>Applicant(s)</b> KULPER ET AL.	
	<b>Examiner</b> RONAK C. PATEL	<b>Art Unit</b> 4132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/22/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20060822 20080725</u> .                                       | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "It is being possible for the self-adhesive compound to be a rubber or acrylates or silicone adhesive" is indefinite since it is unclear whether rubber or acrylates or silicone adhesive is required in the claim. Thus, the scope of the claim is indefinite.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2 and 4-11 are rejected under 35 U.S.C. 102 (b) as being anticipated by Samson-Himmelstjerna et al. (US 2003/0198806).
5. Regarding claim 1, Samson-Himmelstjerna discloses an abrasion resistant tape for bandaging cable harnesses comprising a backing layer having two layers and an interlayer having an adhesive composition use to laminate the two layers comprising backing material (Para 0056). Samson-Himmelstjerna also discloses the backing material for the adhesive tape can be composed of woven or knits (para 0027) and the interlayer is composed of double sided adhesive tape (para 0057).

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6. Regarding claim 2, Samson-Himmelstjerna discloses that the adhesive composition used in the interlayer being composed of viscoelastic adhesive or double sided adhesive based on different polymer system, with natural or synthetic rubber and polyacrylates or silicones (para 0057).

7. Regarding claim 4, Samson-Himmelstjerna discloses the inter adhesive coating applied to the backing has a basis weight of 25 to 80 g/m<sup>2</sup>, which falls in the range of claim limitation (para 0085).

8. Regarding claim 5, Samson-Himmelstjerna discloses the base materials of the backing may be chosen from the woven belt of glass fiber, polyester or polyamide, which reads on the claim. The base of the backing layer is similar to the outer layers A and B of the present application as explained in claim 1.

9. Regarding claim 6, Samson-Himmelstjerna discloses an abrasion resistant tape for comprising a backing layer having two layers composed of woven or knits (para 0027) and an interlayer having an adhesive composition use to laminate the two layers comprising backing material (Para 0056) and the interlayer is composed of double sided adhesive tape (para 0057). Samson-Himmelstjerna discloses the inter adhesive coating applied to the backing has a basis weight of 25 to 80 g/m<sup>2</sup> and also discloses the layer composed of viscoelastic adhesive such as polyacrylates or silicones.

10. Regarding claim 7, see discussion for claim 1. Samson-Himmelstjerna discloses the backing is coated on at least one side with a silicone adhesive composition (para 0057).

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11. Regarding claims 8 and 9, see discussion for claim 1. Samson-Himmelstjerna discloses a method for wrapping an elongate product guiding tape in a helical spiral around the elongate product, which also covers the elongate product in its axial direction (para 0019).

12. Regarding claim 10, see discussion for claim 1. Samson-Himmelstjerna discloses a method of wrapping an elongate product, especially cable harnesses with a tape (abstract).

13. Regarding claim 11, see discussion for claim 1. Samson-Himmelstjerna discloses a method of wrapping an elongate product, especially cable harnesses with a highly abrasion resistant tape which is used in the vehicles, as mentioned by the applicant in the specification that the highly abrasion resistant tape is used for bandaging cable harnesses in automobiles, which therefore meets the claim limitation 11.

***Claim Rejections - 35 USC § 102/103***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. Claim 3 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Samson-Himmelstjerna et al. (US 2003/0198806).

17. Regarding claim 3, Samson-Himmelstjerna discloses an abrasion resistant tape for bandaging cable harnesses comprising a backing layer having two layers and an interlayer having an adhesive composition use to laminate the two layers comprising backing material (Para 0056). Samson-Himmelstjerna also discloses the backing material for the adhesive tape can be composed of woven or knits (para 0027) and the interlayer is composed of double sided adhesive tape (para 0057). However, Samson-Himmelstjerna fails to mention that the abrasion resistance of the backing (measured in accordance with ISO 6722, section 9.3 "scrape abrasion resistance") is at least 150% of the sum of the abrasion resistance of the individual piles.

18. However, Samson-Himmelstjerna discloses that the adhesive composition used in the interlayer being composed of viscoelastic adhesive or double sided adhesive based of different polymer system, with natural or synthetic rubber and polyacrylates or silicones (para 0057) and the inter adhesive coating applied to the backing has a basis weight of 25 to 80 g/m<sup>2</sup>, which falls in the range that the applicant has disclosed in his specification. Samson-Himmelstjerna also discloses the base materials of the backing may be chosen from the woven belt of glass fiber, polyester or polyamide, similar to the backing material as used by the applicants in his invention and also it is not found that the production methods of these are meaningful different. Therefore, it would be expected that they would inherently exhibit similar or substantially similar properties

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having abrasion resistance of the backing (measured in accordance with ISO 6722, section 9.3 "scrape abrasion resistance") is at least 150% of the sum of the abrasion resistance of the individual piles.

19. The Patent and Trademark Office can require Applicant to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on Applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 U.S.P.Q. 431 (CCPA 1977).

### **CONCLUSION**

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RONAK C. PATEL whose telephone number is (571)270-1142. The examiner can normally be reached on Monday to Thursday from 8am-5pm Eastern.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael LaVilla can be reached on 571-272-1539. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. C. P. /

Ronak C Patel

Patent Examiner, Art Unit 4132

07/02/2009

**/Michael La Villa/**

**Michael La Villa**

**Supervisory Patent Examiner, Art Unit 4132**

**5 July 2009**